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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,462	10/17/2003	Daryoush Allaei	102.003US03	3021
7590	08/03/2004		EXAMINER	
Leffert Jay & Polglaze, P.A. P.O. Box 581009 Minneapolis, MN 55458-1009			LUONG, VINH	
			ART UNIT	PAPER NUMBER
			3682	

DATE MAILED: 08/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/688,462

Applicant(s)

ALLAEI, DARYOUSH

Examiner

Vinh T Luong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/28/2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 15-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,7,10 and 11 is/are rejected.
- 7) ☒ Claim(s) 4-6,8,9 and 12-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


Vinh T. Luong
Primary Examiner

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Applicant's election of the species of Figs. 9 and 10 in the reply filed on April 28, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Applicant merely states that Applicant elects with traverse. Applicant does not specifically point out the reasons on which Applicant bases his conclusion that the restriction requirement is in error. See MPEP § 818.03(a) quoted below:

818.03(a) Reply Must Be Complete

As shown by the first sentence of 37 CFR 1.143, the traverse to a requirement must be complete as required by 37 CFR 1.111(b) which reads in part: "In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. . . ." The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. . . ."

Under this rule, the applicant is required to specifically point out the reasons on which he or she bases his or her conclusions that a requirement to restrict is in error. A mere broad allegation that the requirement is in error does not comply with the requirement of 37 CFR § 1.111. Thus the required provisional election (see MPEP § 818.03(b)) becomes an election without traverse.

2. Claims 2 and 15-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 28, 2004.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear whether the term that appears at least twice, such as, "a sensor" in claims 10 and 11, which in turn are dependent upon claim 7, refers to the same or different elements. See MPEP § 2173.05(o).

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970) and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 3, and 7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3 and 7 of U.S. Patent No. 6,116,389

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(Pat.'389). Although the conflicting claims are not identical, they are not patentably distinct from each other because applicant apparently uses a slightly different terminology in order to claim substantially the same invention. *In re Griswold*, 150 USPQ 804 (CCPA 1966) and MPEP 804.02. For example, see the comparison of claims 1, 3, and 7 of this application and claims 3 and 7 of Pat.'389 below:

Common	SN'462	Pat.'389
a structure		
a vibrating member		
a vibration confinement device		
		a vibration damping element
boundaries		
vibration confinement region		
an effective torsional stiffness		
an effective translational stiffness		
an operating position		
a determined position		
		an active vibration damping element
an active vibration confinement device	claim 3	claim 7
a sensor	claim 7	claim 3

Claims 1, 3, and 7 of this application do not recite the vibration damping element and the active vibration damping element. However, the claimed method for controlling vibration in this

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application inherently includes the vibration damping element and the active vibration damping element to dampen the vibration. Without the vibration damping element and the active vibration damping element, the claimed method for controlling vibration in this application would be inoperative. In any event, all of the claimed steps in claims 1, 3, and 7 of this application are explicitly taught or suggested by claims 3 and 7 of Pat.'389. It would have been obvious to one having ordinary skill in the art at the time the invention was made to perform the method for controlling vibration in claims 1, 3, and 7 of this application as taught or suggested by claims 3 and 7 of Pat.'389.

7. Claims 4-6, 8, 9, and 12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 10 and 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

9. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

10. The following is a statement of reasons for the indication of allowable subject matter:

(a) The first closest prior art, i.e., the publication "Mode Localization Phenomena in Large Space Structure" of Bendiksen does not teach or suggest the method for controlling vibration energy using, among other things, a vibration confinement device. See the decision of

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the Board of Patent Appeals and Interferences on December 23, 2002 during the prosecution of parent Application No. 09/328,918; and

(b) The second closest prior art Walkowc (US Patent No. 5,553,514) does not teach or suggest the method for controlling vibration energy comprising, *inter alia*, the step of determining an effective torsional stiffness and an effective translational stiffness. See the Board decision mentioned above.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Allaei'242 (claims 1-7), Heiland (claims 15-18), Hagar et al. (sensor 15-20), Harper (active vibration confinement device in Fig. 3), and Morgenthaler (vibration confinement device 16).


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 703-308-3221. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 703-308-3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Luong

July 28, 2004


Vinh T. Luong
Primary Examiner